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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/130,593	08/07/98	GUST	

IM22/1121
ROBERT W BECKER & ASSOCIATES
SUITE B
11896 N HIGHWAY 14
TIJERAS NM 87059

EXAMINER
FIGUEROA, J

ART UNIT
1772

PAPER NUMBER

DATE MAILED: 11/21/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/130,593

Applicant(s)

Herbert Gust

Examiner
John J. Figueroa

Group Art Unit
1772



☒ Responsive to communication(s) filed on Sep 11, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1035 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-25 is/are pending in the application.

Of the above, claim(s) 17-25 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-16 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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RESPONSE TO AMENDMENT

I. ELECTION/RESTRICTION

1. Applicant's election of Group I, claims 1-16 in Paper No. 4 (mailed March 2, 2000) is re-acknowledged. Because Applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

2. Accordingly, the requirement is still deemed proper and is therefore made FINAL. Claims 17-25 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

II. REJECTIONS REPEATED

3. The 35 U.S.C. §103 rejection of claims 1-16 over Heine (US 5874170) in view of Krause (US 5958532) is repeated for reasons previously of record in Paper #4, Page 3, Paragraph #6.

III. ANSWERS TO APPLICANT'S ARGUMENTS

4. Applicant's arguments filed in Paper #6 (filed September 11, 2000) regarding the 35 U.S.C. §103 rejection of claims 1-16 over Heine in view of Krause have been carefully considered but are deemed unpersuasive.

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Applicant's claimed invention is not patentably distinct from Heine and Krause's disclosed structure.

Regarding Applicant's arguments concerning the references failing to show certain features of Applicant's invention, it is noted that the features upon which applicant relies on (i.e. the "chemically and morphologically altered" polyfluorocarbon surface portions, the plasma polymerization process providing "superior adhesive strength", the "micro-sandblasting effect", "chemical changes" in the surface's "micro area", the "permanently and fixedly connected other materials", elastomeric materials "received into the micro-cavities to form a chemical connection between materials", the adhesion between the connecting portions being so strong that they are not separable under stress) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to Applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. *In re Nomiya*, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art, rather than by their specific disclosures. *In re Bozek*, 163 USPQ 171, 174.

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In response to applicant's arguments against the Heine and Krause references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Thus, in the absence of any factual evidence or objective showing proffered by Applicant to the contrary, it remains the Examiner's position that Applicant's claimed invention is rendered obvious by the prior art of record as discussed above.

IV. CONCLUSION

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Figueroa whose telephone number is (703) 305-0582. The Examiner can normally be reached on Monday through Thursday from 7:00 a.m. to 5:30 p.m.

If the attempts to reach the Examiner are unsuccessful, the Examiner's supervisor, Ellis P. Robinson can be reached by dialing (703) 308-2364. The fax phone number for the organization where this application is assigned is (703) 305-5408.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose phone number is (703) 308-0661.

jjf 

November 15, 2000


Ellis Robinson
Supervisory Patent Examiner
Technology Center 1700